

09/398,377

12969

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**#24/jan  
10 22-02

In re Application of: )

Group Art Unit: 1714

BITLER, Steven P. et al. )

Examiner: Peter A. Szekely

Serial No.: 09/398,377 )

Filing Date: September 17, 1999 )

For: POLYMERIC )  
THICKENERS FOR )  
OIL-CONTAINING )  
COMPOSITIONS )

Pasadena, California

**DECLARATION OF DAVID C. STEINBERG**  
**UNDER 37 C.F.R. § 1.132**Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

I, David C. Steinberg, declare that:

**I. MY BACKGROUND**

1. As detailed below, I am an expert in the chemistry of cosmetic products. Attached is my CV and list of publications. These documents truly and correctly represent my experience and publications.

07 Declaration of Steinberg

09/398,377 12969

2. I founded in 1995 and am currently the CEO of Steinberg & Associates, Inc., a consulting firm for the cosmetic industry specializing in the chemistry of cosmetic ingredients, preservatives and preservation, international and U.S. cosmetic regulations, and marketing of raw materials to the personal care industry.
3. From 1982 to 1995, I worked for Sutton Laboratories (acquired by International Specialty Products ("ISP") in 1989) in several capacities including Vice President, Senior Industry Fellow and Worldwide Director of Technical Services and Applications for ISP. Senior Industry Fellows are the highest level of scientific personnel at ISP. When I was a Senior Fellow, there were only 3 out of approximately 15,000 employees. As Worldwide Director, five laboratories located throughout the world reported to me and I coordinated technical services and customer requirements.
4. I have authored 3 books, 6 chapters of books, and 38 articles and I have co-authored 1 book and 2 chapters of books, as listed in the attached list of publications. All of the articles and half of the books relate to the chemistry of cosmetic ingredients. The remainder relate to cosmetic regulations. In addition, I have served on the editorial boards of the *Journal of Cosmetic Science* and the *Journal of Applied Cosmetology* and have been on the advisory board of *Cosmetics & Toiletries* magazine since 1997.
5. My work in the chemistry of cosmetic ingredients has led to me being elected a Fellow of the Society of Cosmetic Chemists. The Society of Cosmetic Chemists has also honored me with their Merit Award. I was named Eminent Visiting Scholar by Virginia State University and, in 1988, I received the paper of the year award from the Australian Society of Cosmetic Chemists.

09/398,377 · 12969

6. From 1982 to 2000, I was an Adjunct Assistant Professor of Chemistry in the Graduate School of Chemistry at Fairleigh Dickinson University. I am also the inventor of the invention claimed in U.S. Patent No. 5,888,486 for antiperspirant composition.
7. In 2000-01, I worked as a consultant for Dock Resins Corporation, which is owned by Landec Corporation. I was paid \$5,000.00 plus expenses by Dock Resins Corporation for this work. I am drafting this declaration as a consultant for Landec Corporation. I am being paid \$350/hr for my time drafting this declaration.

## II. MATERIALS REVIEWED

8. I have read and I understand the written specification and the amended claims in U.S. patent application S/N 09/398,377, filed September 17, 1999 and I read and understood the rejection mailed by the U.S. Patent and Trademark Office on July 31, 2002 (paper no. 21) rejecting the specification on the grounds that it introduces new matter into the disclosure; rejecting claims 2, 5, 7-10, 12-14 and 17-27 on the grounds that they contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention and on the grounds that they contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains or with which it is most nearly connected, to make and/or use the invention; and rejecting claims 2, 5, 7-14, and 17-27 as anticipated by or, in the alternative, as obvious over Mueller et al. 5,281,329.

09/398,377 12969

### III. MY OPINIONS AND FACTUAL BASIS FOR OPINIONS

#### A. The inventors had possession of the claimed invention

9. It is my opinion that the language “The polymeric thickener should be used in an amount sufficient to thicken the oil” is inherently within the original disclosure and one skilled in the art would recognize that this was disclosed. Further, it is my opinion that the original disclosure reasonably conveyed to one skilled in the art that the inventor had possession of the claimed subject matter at the time of filing, in particular the subject matter of claims 2, 5, 7-10, 12-14 and 17-27. Facts supporting this opinion are as follows.
- i. At Page 9, lines 12-15 the specification describes the amount of polymeric thickener typically needed as in the range 3-7%. It is clear to me that if you added less than 3% you would not get a sufficient increase in viscosity and that the point of the given range was to guide one making the invention to use the polymeric thickener in an amount sufficient to thicken the oil. The table on page 11 again shows different viscosities in constant oil with different polymers and also show different viscosities with different oils.
  - ii. Hence, it is inherent in the disclosure that the polymeric thickener should be used in an amount sufficient to thicken the oil and the amount sufficient to thicken the oil is at least 3% by weight.
10. It is my opinion that the claimed subject matter is described in the original specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected to make and/or use the invention without undue experimentation,

09/398,377 12969

in particular the subject matter of claims 2, 5, 7-10, 12-14 and 17-27. Facts supporting this opinion are as follows.

- i. The specification as filed contains, on page 9, lines 12-14, an indication of the amounts of the SCC polymer that are preferably used to thicken the oil. The table on page 11 provides specific examples of thickened oils.
- ii. The thickening of oils by the addition of suitable additives is a well-known technology, as evidenced by the numerous prior art documents, which are of record in this application. For example, U.S. Patent No. 5,736,125 (Morawsky), which is incorporated by reference in the application as filed (see page 1, lines 10-13) states in column 3, lines 19-21,

*In the compositions, the amount of thickening copolymer... is present in an amount sufficient to thicken the composition to the desired thickness.*

- iii. Those skilled in the art will have no difficulty, therefore, having regard to their own knowledge, the disclosure of this application, and routine experimentation, in determining the amounts of SCC polymer to be used for thickening oils. In fact, using the compounds (polymers) and oils disclosed in the specification, it would only take one skilled in the art and having the necessary equipment a short amount of time to determine the amount of polymer needed to achieve the desired thickness.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the Bitler application or any resulting patent

09/398,377 12969

declares that all statements made of his own knowledge are true and that all statements made on information and belief are believed to be true.

Dated: 10/17/02By David C. Steinberg

David C. Steinberg

*Curriculum Vitae***David C. Steinberg**

**Education:** BS Chemistry, Drexel University, 1965  
MBA Management, Pace University, 1969

**Occupation:** 1995 Founded Steinberg & Associates, Inc.  
A consulting firm for the Cosmetic industry  
Specializing in the Chemistry of Cosmetic Ingredients,  
Preservatives and preservation, International & US  
Cosmetic Regulations, and marketing of raw materials

1982-1995 Sutton Laboratories (acquired by ISP in 1989)  
1994- Worldwide Director, Technical Services and  
Applications, Skin Care-ISP  
1994 Named Senior Industry Fellow  
1988-94 Vice President, Sutton Labs  
1982-87 Sales Manager, Sutton Labs

1979-1982 Tri-K Industries  
1981-82 Manager, Technical Services  
1979-81 Technical Sales Representative

1978 Miranol Chemical, Technical Sales

1977 Scher Chemical, Vice President

1976 Chattem Drug and Chemical Company-Technical  
Advisor

1969-76 Emery Industries  
1974-6 Manager Cosmetic Specialties  
1969-4 Technical Sales Representative

1965-68 Neville Chemical Company, Technical  
Representative

1962-65 Co-op Student- Drexel Institute of Technology  
GAF Corp.-Research Chemist  
Atlas Chemical-QC Chemist  
Drexel-Instructor-Freshman Chemistry

**Academia:**

Fairleigh Dickinson University  
1982 to 2000  
Adjunct Assistant Professor of Chemistry  
Graduate School of Chemistry  
"Skin Care Raw Materials"  
"Hair Care Raw Materials"  
"Chemistry of Cosmetic Raw Materials"

Center For Professional Advancement  
"Cosmetic Preservation"  
"Cosmetic Product Stability"  
"Critical Components of Skin Products"  
"Sunscreens" (Director)  
"International Cosmetic Regulations"  
"Labeling Over-the-Counter Drugs" (Director)

Society of Cosmetic Chemist, Continuing Education Program,  
"Cosmetic Raw Materials"  
"Preservatives for Cosmetics"

**Memberships:**

American Chemical Society  
Institute of Food Technologists  
Regulatory Affairs Professionals Society  
Society of Cosmetic Scientists  
Society of Cosmetic Chemists  
    Offices: New York Chapter Chair, 1979  
              National Treasurer, 1987-8  
              National President, 1991  
Praesidium: International Federation of Societies of Cosmetic  
Chemists, Honorary Auditor, 1992-5  
              Scientific Committee, 1995-8

**Honors:**

Society of Cosmetic Chemists, Merit Award, 1985  
Society of Cosmetic Chemists, Fellow, 1987  
Eminent Visiting Scholar, Virginia State University, 1987  
Paper of the Year, 1988, Australian Society of Cosmetic  
Chemists  
IFSCC Sponsored Speaker, Brazil 1996, 2000



**Miscellaneous:** Columnist on International Cosmetic Regulations, *Cosmetics & Toiletries Magazine* 1995-present

Analyst, *Kosmet* Data Base, 1995-1998

Board of Directors, Hansotech, Inc. 1998

Board of Directors, ICMAD 1999-2003

Strategic Planning Advisory Board, Renaissance Pharmaceutical Company

Editorial Board *Journal of Cosmetic Science*, 1998

Editorial Board *Journal of Applied Cosmetology*, 1998

Advisory Board *Cosmetics & Toiletries* magazine 1997-present

Chairman, Preservatech Conference, 1998, Paris, France

Chairman, Preservatech Conference, 1999, Chicago, IL

Patent: 5,888,486 Antiperspirant Composition, 3/30/1999

**Books:** *Preservatives For Cosmetics*, Allured Publishing, 1996

*A Guide to European Cosmetic Regulations*, ICMAD, 1998

*Primary Ingredients*, (With Anthony J. O'Lenick, Jr), Hansotech Publication, 1998

*FDA OTC Label Requirements Guidelines*, Hirschhorn & Young, 2000

Chapters:

*Advanced Technology Conference 1996, Cosmetics & Toiletries*, Chapter on Cosmeceuticals: An American Perspective

*Transdermal and Topical Drug Delivery Systems*, Co-Author of Chapter: Topical Protective and Cosmetic Products, Interpharm Press, 1997

*Sun Products*, Co-Author of Chapter: Encyclopedia of UV Absorbers for Sunscreen Products, Allured Publishing, 1998

*Sunscreen Regulations: US, Europe, Australia and Japan*, Co-Author of Chapter: Cosmetic Regulations in a Competitive Environment, Marcel Dekker, 2000

*Antiperspirants and Deodorants*, Author of Chapter: Regulations of Underarm Antiperspirants and Deodorants, Marcel Dekker, 1999

*Botanicals in Cosmetics*, Author of Chapter: The Regulation of Botanicals in Cosmetics Marcel Dekker (expected 2002 ?)

*The Chemistry and Manufacture of Cosmetics*, Author of Chapter: Cosmetic Microbiology and Preservation, Allured Publishing Corp., 2000

*Fundamentals of EU Regulatory Affairs*, Author of Chapter: Cosmetics, RAPS, 2002

**Legal Experience:** Expert Witness: Revlon versus L'Oreal  
1996-7. Paul Weiss, Rifkind, Wharton & Carrison  
Consultation, Expert Report, Depositions

Expert witness: Procter & Gamble versus Conopco, Inc.  
1998. Howrey & Simon, Consultation, Expert Report

Consultation: Price, Heneveld, Cooper, DeWitt & Litton.  
Patents, Reports 1998-9

Consultation: R. Kunstadt, P.C. Patents 1999

Consultation: Olson & Hierl, Ltd. Patents 1998-02

Expert witness: DPT versus BBW 1999, Vorys, Sater,  
Seymour and Pease LLP 1999, Consultation

Expert Witness: Anita S. Nooe and Linwood Nooe v. Unilever USA, Inc. 2000-1, Scruggs, Millette, Bozeman & Dent  
Expert Witness Report, Deposition, Consultation

Expert Witness: Alberta E. Richardson, et al. v. Carson Products Company, Inc. et al. 2000-, Holland & Knight LLP, Consultation, Deposition, Hearing

Expert Witness: Sandra L. Bronner, et al. v. Mercantile Stores, Inc. 2000-1, ICE Miller, Consultation

Expert Witness: Johnson Marketing adv. Desert Dust Cosmetics, 2000-2, Best Best & Krieger LLP, Consultation, Depositions

Expert Witness: Taglieri v. Perrigo, et al. 2001-2, BHLaw, Consultation, Court Testifying

Expert Witness: Sayles v. Johnson Products Company, Inc. 2001, Jackson & Kelley PLLC, Consultation

Expert Witness: Amy Nitz, et.al v. Vogue Hair Studio, Inc. et.al, 2001-2 Barnes & Thornburg; Hoppe, Consultation, Depositions

Expert Witness: Spa De Soleil Inc. V. Gary V Berger, William R. Windette; R.T. Beers & Co. 2002- Ricks Rainey, Consultation, Depositions

#### **Regulatory Accomplishments:**

Testified Before the FDA (at their request) on Sunscreen Regulations, and Regulations of Over-The-Counter Drugs.

Authored the change in US regulations of OTC Drugs on the acceptance of foreign data for US approvals.

Submitted and had approval from the European Union on moving three prohibited ingredients in cosmetics, to being allowed under restricted conditions. This was the first time in the history of the EU cosmetic regulations that this was achieved (2001-2).

David C. Steinberg

5/8/02

## **Publications**

Synthetic Squalene for Cosmetics, *Drug & Cosmetic Industry* 129,3 September 81

Aminoefaderma: Aid to Skin Elasticity, *Cosmetic Technology* 3,11 November 81

Mucopolysaccharides for Cosmetics, *Cosmetic Technology* 4,2 February 82

Acanthogenesis in Oils for Skin, *Journal of the Society of Cosmetic Chemists* 32,2 March 82

Alternative Methods for the Formulation of Anhydrous Lipidic Systems for Topical Use, *Relata Technica* 31, 1982

Surfactants in Current Shampoos, *Relata Technica* 53, 1982

Germaben II- A Complete Preservative System in Clear Liquid Form  
*Cosmetic & Toiletries* 97,11 November 1982

Cutaneous Effects of Various Lipoplastidines, *Drug & Cosmetic Industries* 132,2 February 1983

Protecting Shampoos with Two New Preservatives, *Cosmetic Technology* 5,2 February 1983

Cosmetic Preservatives, *Drug & Cosmetic Industries* 135,5 May 1984

A Review of Cosmetic Preservatives and Problems in Their Utilization, *Cosmetics Aerosols & Toiletries* 3,3 January 1989

Botanical Extracts and Preservation Issues, *Cosmetics & Toiletries* 106,2 February 1991

Preservatives, *Inform* 3,1 January 1992

Sodium Hydroxymethylglycinate-The Unique Preservative and Formulation Aid, *Proceedings the Australian Society of Cosmetic Chemists*, Feb. 1992

Cosmetic Preservation: Current International Trends, *Cosmetics & Toiletries* 107,9 September 1992

Maleated Soybean Oil and Its Multifunctional Properties, *Proceedings of In-Cosmetics*, Barcelona, 1994

The New Tentative Final USA Monograph on Sunscreens, *Proceedings of the 4th Joint Conference of the Australian and New Zealand SCC*, May 1994.

Preserving Foundations, *Cosmetics & Toiletries* 110,2 February 1995.

Liquid Parabens, The Next Generation of Preservation, *Drug & Cosmetic Industry*, 157, 4, October 1995.

Frequency of Use of Preservatives in the United States 1996, Proceedings of Preservatech 1996, pages 8-18.

Frequency of Use of Preservatives, *Cosmetics & Toiletries* 112,2 February 1997

"Natural" Preservatives, *The Worldwide Directory for the Cosmetic Industry*, 37-38, 1998

Waxes for the Third Millenium, Symposium on Cosmetics-The Next 50 Years, Manchester, UK, 1998

The Regulations of Personal Care Products in the USA and Global Harmonization, Conference Proceedings, International Cosmetic Expo, 1999

The Regulations of the Preservation of Cosmetics in the European Union, Proceedings of Preservatech 1999, pages 14-19

Animal vs. Vegetable: A Continuing Controversy, *Skin, Inc.* 11(2) April, 58-62, 1999

Grassi oli e cere, *Cosmetic Technology*, 2 (2), March 58-61, 1999

Caveat Emptor, *Skin, Inc.* 11(7) August, 46-51, 1999

Productos Elaborados con Drogas Filtradoras Solares Libres de Prescripción Médica: Monografía Final, *Cosméticos Nuevos*, 6 (1) February, 27-36, 2000

OTC Drug Facts Labeling, Conference Proceedings, International Cosmetic Expo, 2000

Sunscreen Drug Products for Over-The Counter Use: Final Monograph, Conference Proceedings, International Cosmetic Expo, 2000; Proceedings 34<sup>th</sup> Conference ASCC

A New Photostabilizer for Full Spectrum Sunscreens, *Cosmetics & Toiletries* 115 (6) 37-45, June 2000

Measuring Synergy, *Cosmetics & Toiletries* 115 (11) 59-62, November 2000

3

The Impact on Fragrances: The European Cosmetic Directive, *Global Cosmetic Industry*, 29-34, February 2002

A Modern Relationship, *Global Cosmetic Industry*, 30-34, March 2002

Frequency of Use of Preservatives 2001, *Cosmetics & Toiletries* 117 (4) 41-44, April 2002

Sunscreen Drug Products for Over-The Counter Use: Final Monograph, *Cosmetics Aerosols & Toiletries in Australia* 15 (1) 23-31 February 2002

European Cosmetic Regulatory Update, *Perfumer & Flavorist* 27 (3) 40-6, May/June 2002

### Chapters in Books

Cosmeceuticals: An American Perspective , Advanced Technology Conference 1996 *Cosmetics & Toiletries*.

Topical Protective and Cosmetic Products, *Transdermal and Topical Delivery Systems*, Interpharm Press, 1997

Sunscreen Regulations: US, Europe, Australia and Japan , *Cosmetic Regulations in a Competitive Environment*, Marcel Dekker 2000

Encyclopedia of UV Absorbers for Sunscreen Products , *Sun Products*, Allured Publishing, 1998

Regulations of Underarm Antiperspirants and Deodorants , *Antiperspirants and Deodorants*, Marcel Dekker , 1999)

The Regulations of Botanicals in Cosmetics, *Botanicals in Cosmetics*, Marcel Dekker (Expected 2001)

Cosmetic Microbiology and Preservation, *The Chemistry and Manufacture of Cosmetics*, Author of Chapter: Allured Publishing Corp., 2000

Cosmetics, *Fundamentals of EU Regulatory Affairs*, Author of Chapter: RAPS, 2002

### Books

*Preservatives for Cosmetics*, Allured Publishing, 1996

*A Guide to European Cosmetic Regulations*, ICMAD, 1998

*Primary Ingredients*, Hansotech, Inc. 1998

*FDA OTC Label Requirements Guidelines*, Hirschhorn & Young, 2000